

**REMARKS**

**Claim Rejections - 35 U.S.C. §102**

**Claim 6 is rejected under 35 U.S.C. §102(b) as being anticipated by Fujitsu Limited (EP patent 0897161 cited by Applicant).**

Even though the instant application is filed in the U.S. on June 7, 2001, the instant application claims an earliest priority date on February 24, 1999 under 35 U.S.C. 119. The asserted prior art EP 0897 161A1 has a publication date of February 17, 1999, less than one year prior to the earliest priority date on February 24, 1999. Therefore, the instant application is not anticipated by EP 0897 161A1 under 35 U.S.C. 102(b).

Should the Office wish to assert either 102(a), 102(e) or 103(a) as grounds of rejection to assert EP 0897 161A1 to reject the claimed invention, MPEP 706.02(a) has specifically stated that:

“references that are only prior art under 35 U.S.C. 102(e), (f), or (g) and applied in a rejection under 35 U.S.C. 103(a) are subject to being disqualified under 35 U.S.C. 103(c) if the reference and the application were commonly owned, or subject to an obligation of common assignment, at the time the invention was made.< For 35 U.S.C. 102(a) to apply, the reference must have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work.”

In the instant application, the earliest priority date is asserted to be February 24, 1999 and an actual U.S. filing date to be June 7, 2001.

The prior art EP 0897 161A1 having an earliest priority date of August 7, 1997. As it can be readily verified, EP 0897 161A1 and the present application all have a common assignee Fujitsu Limited. In fact, one of the inventors of the asserted prior art is also the inventor of the present

invention. Specifically, Mr. Fumihiko Nakazawa is an inventor for both EP 0897 161A1 of the present invention.

As the asserted prior art references and the present application were commonly owned, or subject to an obligation of common assignment, at the time the present invention was made, the asserted prior art references are subject to being disqualified under 35 U.S.C. 103(c).

Therefore, rejection under 102(a), 102(e) and 103(a) would be statutorily disqualified by acts of Congress as well as by the U.S. Patent and Trademark Office as stipulated in MPEP 706.02(a).

Reconsideration and withdrawal of this rejection are respectfully requested.

**Claim Rejections - 35 U.S.C. §103**

**Claims 1-5 and 7 are rejected under 35 USC §103(a) as being unpatentable over Junkins et al. (U.S. Patent No. 5,525,746 cited by Applicant) in view of Brandt (U.S. Patent No. 5,438,446).**

Regarding claim 1, the outstanding Office action has specifically recited that "Junkins et al. do not disclose the deflecting unit has an asymmetrical shaped about an optical axis." The Applicant agrees with this Office assessed shortcoming of Junkins.

To supplement this shortcoming of Junkins, the outstanding Office action asserted that "Brandt discloses in Figure 4 an optical scanner for scanning a light beam onto an image object having an asymmetrical shaped about an optical axis (see mirror N1 asymmetry through vertical axis 00-01, see column 6, lines 20-25)."

Therefore, it is a firm Office position that Figure 4 of Brandt and associated written description discloses an image object having an asymmetrical shaped about an optical axis.

Column 6 lines 20-25 only stated that:

“The reflected light beam is made up of three reflectance components 51, 52 and 53 which are reflected from the air-coating interface  $N_{\text{sub}.0}$  -  $N_{\text{sub}.1}$ , the coating-polished mirror surface interface  $N_1$  -  $N_2$  and the reflectance of a portion of beam 52 back at the air-coating interface to the other interface, respectively.”

Junkins (U.S. Patent No. 5,525,746) discloses a “scan mirror”, a “parabolic collector” and a “photo-detector”, respectively corresponding to an “optical scanning unit”, a “deflecting unit” and a “light receiving unit”, which allegedly corresponds to claim 1 of the present invention. However, unlike claim 1 of the present invention, the “parabolic collector” is symmetrical about an optical axis. In view of the above, the Office cited Brandt as an example disclosing a member corresponding to the “deflecting unit” asymmetrical about an optical axis. In view of the above, the Office cited Brandt as an example disclosing a member corresponding to the “deflecting unit” asymmetrical about an optical axis, asserting that Brandt discloses such an example in column 6, lines 20-25. Brandt does not substantiate the Office assertion. The cited part of Brandt merely describes reflected light beam in the case where a light beam is allowed to enter a component of two types of materials (each having a refraction factor of  $N_1$  and  $N_2$ ) diagonally through the air (having a refraction factor of  $N_0$ ) toward a material having a refraction factor of  $N_1$ . It is completely inappropriate to assert that the mirror of Brandt corresponds to the “deflecting unit” of claim 1 of the present invention.

Regarding claim 7, the outstanding Office action has specifically recited that "Junkins et al. do not disclose the optical scanning unit is provided with a protective film having a maximum reflectance at an angle of incidence to a scanning angle at which a quality of the reflected light is minimum." The Applicant agrees with this Office assessed shortcoming of Junkins.

To supplement this shortcoming of Junkins, the outstanding Office action asserted that "Brandt discloses in Figures 5-6, a reflectance of a aluminum mirror substrate having SiO<sub>2</sub> protective coating (protective film) and having the optimal thickness to be employed to minimize reflectance variations in the range of incident light beam scanning angles (that is the quality of reflected light is minimum), therefore, the protective film having maximum reflectance (see column 6, lines 26-47).

Junkins discloses a "retro-reflector", a "scan mirror", and a "photo detector", respectively corresponding to a "light retro-reflector", an "optical scanning unit" and a "light receiving unit", which allegedly corresponds to claim 7 of the present invention. However, Junkins does not disclose a "protective film" of claim 7 of the present invention. The Office asserts that Figs. 5 and 6 of Brandt illustrate an example of it. However, it is impossible. Brandt discloses a SiO<sub>2</sub> film having an optimum thickness to be employed to minimize reflectance variations according to incident angles, whereas claim 7 of the present invention discloses a SiO<sub>2</sub> film having an optimum thickness to be employed to maximize a reflectance at an angle of incidence corresponding to a scanning angle at which a quantity of reflected light is minimum. In this regard, Brandt is completely different from the present invention.

Section 2143 of the MPEP has specifically stated that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there **must be** some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there **must be** a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be** found in the prior art, and not based on applicant’s disclosure.

Given that the Office cited portion of Brandt does not suggest an image object having an asymmetrical shaped about an optical axis, this rejection has not rise to a level satisfying the standard required to establish a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

**CONCLUSION**

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully Submitted,

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